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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,609	12/28/2000	Marc Traylor	D-6904	8543

26375            7590            07/16/2002  
SINSHEIMER, SCHIEBELHUT, BAGGETT & TANGEMAN  
1010 PEACH STREET  
SAN LUIS OBISPO, CA 93401

EXAMINER
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SZUMNY, JONATHON A

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/751,609	TRAYLOR, MARC
	<b>Examiner</b>	<b>Art Unit</b>
	Jon A Szumny	3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 June 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

This is the second office action for application number 09/751,609, Resilient Magnetic Paint Brush Holder, filed on December 28, 2000.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear if the applicant is intending to claim the subcombination of a holder/improvement **for** fastening/attachable to a paint can **for** supporting a paintbrush, or the combination of the holder/improvement, the paint can and the paintbrush. The preamble of each of claims 1, 4, 7 and 13 states the former, but then the combination is claimed later on (in claims 1 and 4, “**wherein** the distal portion... ...when the paintbrush...”, in claims 7 and 13, “**wherein** the resilient member... ...when the paintbrush...”, in claims 10, 17 and 20, “wherein the resilient member... ...of the paintbrush...” The applicant must make it clear whether the subcombination or combination is intended to be the invention. For instance, stating --**wherein** the resilient member has a force constant selected that is *adapted to produce*.... and --**wherein** the resilient member is *adapted to limit*...-- would claim the subcombination. For the purposes of this office action, the Examiner will assume the **subcombination** is intended to be the invention, and the paint can and paintbrush are **not** part of the

invention. However, for claims 11, 12, 18 and 19, the Examiner will assume the combination is intended to be claimed.

Further regarding claims 7 and 13, a “*sufficient* displacement” is ambiguous because it is not clear exact what range of displacements is encompassed by the term “sufficient.”

For the purposes of this office action, the Examiner will attempt to apply the art as best understood.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10, 13, 15-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Craig '079.

Craig '079 discloses a holder (figures 1,2) comprising a clamp (figures 1,2), a magnet (figures 1,2), a magnet holder (figures 1,2) and a resilient member/spring/length of resilient material (figures 1,2) having a proximal portion (figures 1,2) attached to the clamp and a distal portion (figures 1,2) attached to the magnet.

However, regarding claims 1-6, Craig '079 fails to specifically teach the distal portion to be displaced when subjected to a mechanical shock. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the

resilient member would inherently be displaced when subject to a mechanical shock since there is variable displacement between the distal and proximal portions of the resilient member (column 3, lines 21-22).

With respect to claims 7-9, 13, 15 and 16, Craig '079 fails to specifically teach the resilient member to have a force constant selected to produce a "sufficient" displacement of the distal end when subjected to a mechanical shock. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the resilient member would inherently have some force constant producing some "sufficient" displacement of the distal end when subject to a mechanical shock since there is variable displacement between the distal and proximal portions of the resilient member (column 3, lines 21-22), in addition to the fact that springs possess some inherent force constant.

Regarding claims 10, 17 and 20, Craig '079 fails to specifically teach the resilient member to limit acceleration of an object attached thereto to no more than 0.75 g. It would have been obvious to an ordinary artisan at the time the invention was made that any one of number of resilient members that each limit the acceleration of an object attached thereto to a different degree could be selected, including no more than 0.75 g, depending upon a user's design preferences or the specific dimensions of an object attached to the resilient member, so long as the integrity of the holder is not compromised.

Claims 7, 9-14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent number 3,729,158 to Nagy.

Regarding claims 7, 9, 11-14, 16, 18 and 19, Nagy '158 discloses a holder (figure 1) comprising a clamp (figure 1), a magnet (figure 1), a magnet holder (figure 1) and a resilient member/length of resilient material (figure 1) having a proximal portion (figure 1) attached to the clamp and a distal portion (figure 1) attached to the magnet; wherein the resilient member, the magnet holder and at least a portion of the clamp constitute a single molded structure; wherein the holder further comprises a paint can (6) and a paintbrush (10).

However, Nagy '158 fails to specifically teach the resilient member to have a force constant selected to produce a "sufficient" displacement of the distal end when subjected to a mechanical shock. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the resilient member would inherently have some force constant producing some "sufficient" displacement of the distal end when subject to a mechanical shock since the resilient member is "bendable" (column 1, line 52).

Regarding claims 10, 17 and 20, Nagy '158 fails to specifically teach the resilient member to limit acceleration of an object attached thereto to no more than 0.75 g. It would have been obvious to an ordinary artisan at the time the invention was made that any one of number of resilient members that each limit the acceleration of an object attached thereto to a different degree could be selected, including no more than 0.75 g, depending upon a user's design preferences or the specific dimensions of an object attached to the resilient member, so long as the integrity of the holder is not compromised.

***Response to Arguments***

Applicant's arguments filed June 3, 2002 have been fully considered but they are not persuasive.

Throughout the remarks, the applicant alleges "Craig does not disclose the claimed clamp for engaging..." and "Craig does not disclose the claimed magnet for engaging...". The Examiner disagrees. Clearly, Craig divulges the structure of a magnet and a clamp oriented as required in the claims as previously described in this office action. Moreover, in the middle of page 7, the applicant further avers "...Craig does not disclose the claimed resilient member having a proximal portion attached to the clamp and having a distal portion attached to the magnet...". Again, the Examiner disagrees. As indicated on the attached copy of figures 1 and 2 of Craig, the resilient member does in fact have a proximal portion attached to the clamp and a distal portion attached to the magnet.

The applicant's remaining arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morgillo '269 and Cortina '073 divulge various brush holders.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

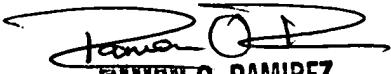
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

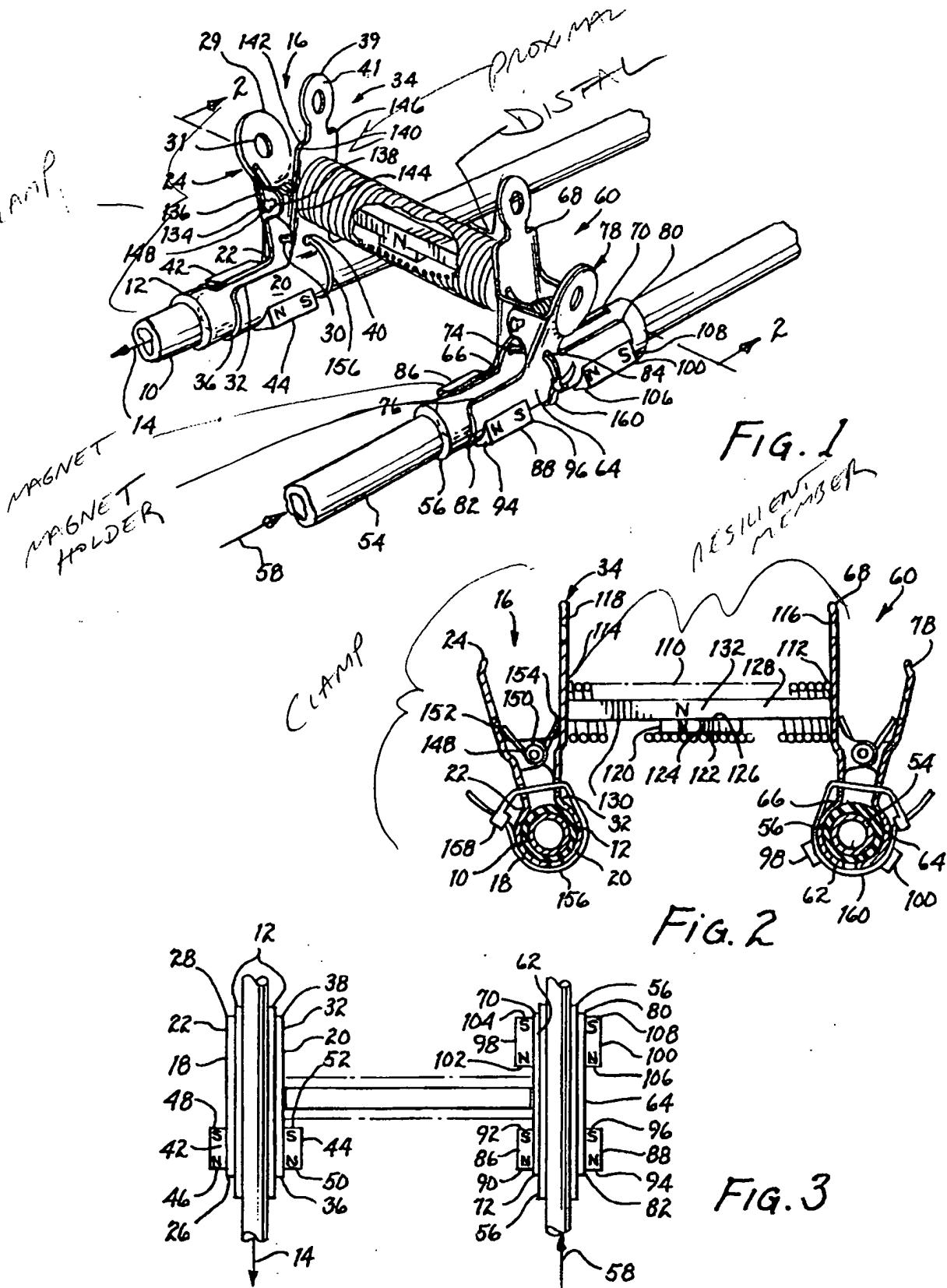
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon A Szumny whose telephone number is (703) 306-3403. The examiner can normally be reached on Monday-Friday 8-4.

The fax phone number for the organization where this application or proceeding are assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Jon Szumny  
Patent Examiner  
Technology Center 3600  
Art Unit 3632  
July 10, 2002

  
RAMON O. RAMIREZ  
PRIMARY EXAMINER  
ART UNIT 3632



Patented April 24, 1973

3,729,158

